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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,566	05/07/2001	Anton Negele	205892USOPCT	1079
22850	7590	03/03/2005		EXAMINER
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			REDDICK, MARIE L	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/830,566	NEGELE ET AL.
	Examiner	Art Unit
	Judy M. Reddick	1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 September 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Amendment

1. The amendment to the claims filed on 09/03/04 does not comply with the requirements of 37 CFR 1.121(c) because of failure to provide the complete text of Claim 1 (Currently Amended). Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) Claim listing. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) When claim text shall not be presented; canceling a claim.

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) Reinstatement of previously canceled claim. A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell, no ironclad support can be found for the newly added limitation "particle size of from 1 – 10 µm" per claim 1 and, this as such, engenders a New Matter situation.

Specification

4. The amendment filed 09/03/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "particle sizes of from 1 – 10 µm" (page 2 @ line 12) and "hydrolyzed particles before and after the hydrolysis is from 1 to 10 µm" (page 8 @ line 13).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sato et al (U.S. 5,962,570).

Sato et al disclose and exemplify a process for the preparation of an aqueous solution or dispersion containing a water-soluble cationic polymer, useful as a flocculant or paper chemical, wherein said process, basically, involves the steps of: polymerizing a monomer including an N-vinylcarboxylic acid amide represented by the general formula CH₂=CHNHCOR, wherein R represents a hydrogen atom or methyl group such as N-vinylformamide and/or N-vinylacetamide, alone or further in combination with other vinyl monomers such as acrylonitrile, acrylamide, etc. in an aqueous medium in the presence of either or both of a polyethylene glycol and polypropylene glycol, in an amount of 1 to 150 wt.%, based on the total monomer weight, and then modifying(hydrolyzing) the resulting polymer with an acid or base. Specifically, an aqueous composition containing a cationic polymer, which comprises (A) a modified N-vinylcarboxylic acid amide polymer, (B) either or both of a polyethylene glycol and

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polypropylene glycol, and(C) water is disclosed(See the Abstract). Sato et al @ col. 5, lines 9-17, teaches that in order to enhance the precipitability of the polymer, various inorganic salts may be used together with the other antecedently recited components. Sato et al, more specifically @ col. 6, lines 43-67 teaches that the reaction solution(aqueous solution or dispersion) comprising the water-soluble cationic polymer comprises, as main components, three components:(A) a modified N-vinylcarboxylic acid amide polymer,(B) a polyethylene glycol or the like and (C) water wherein, the contents of the modified N-vinylcarboxylic acid amide polymer (A), the polyethylene glycol or the like (B) and water (C) are from 5 to 45% by weight, from 0.05 to 60% by weight, and from 5 to 94.95% by weight, respectively, based on the total weight of the three components (A), (B) and (C). More specifically, Sato et al exemplify processes for preparing aqueous fine dispersions of various N-vinylformamide-containing polymers prepared in the presence of polyethylene glycol and hydrolyzed products therefrom which, according to the Examiners calculations, contain a negligible amount of salt, if any at all(sufficient to meet the claimed limitation “substantially free of stabilizing inorganic salt”). See at least Runs 5-7, 9 & 10. Sato et al therefore anticipate the instantly claimed invention with the understanding that the N-vinylcarboxylic acid amide-containing aqueous fine dispersions and modified products(hydrolyzed) therefrom of Sato et al overlap in scope with the instantly claimed invention. It would be expected that the particle size, as claimed, would be met by Sato et al since the N-vinylcarboxylic acid amide-containing water-soluble polymer of Sato et al is essentially the same as and made under essentially the same conditions as the claimed N-vinylformamide and/or N-vinylacetamide-containing water-soluble polymer. The onus to show that, in fact, this is not the case, is shifted to applicants.

It has been held that where applicants claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is

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appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433(CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594.

As to the dependent claims, if not taught or suggested, the limitations would have been obvious to the skilled artisan and with a reasonable expectation of success, i.e., any additional or particular claim parameters which may not be specifically set out in the references are considered to be inherent in the reference products or not to involve anything unobvious absent a showing to the contrary.

Even if it turns out that the instantly claimed invention is not anticipated by the disclosure of Sato et al, it would have been obvious to the skilled artisan to extrapolate, from the disclosure of Sato et al, the precisely defined aqueous dispersion, as claimed, as per such having been within the general purview of the disclosure of Sato et al and with a reasonable expectation of success.

Response to Arguments

8. Applicant's arguments filed 09/03/04 have been fully considered but they are not persuasive.

Relative to Sato et al----The crux of Counsel's arguments appear to hinge on the particle size, as claimed, not being met by Sato. To this end, a second Declaration of Dr. Braig, argued by Counsel as showing that the particle size of the polymer dispersions of Sato are outside the scope of the invention, as claimed, is not a part of the scanned file. Mere attorney's arguments unsupported by factual data are given little weight. It is well settled that unexpected results must be established by factual evidence (*In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991)).

Relative to the particle size----The Declaration of Dr. Braig under 37 CFR § 1.132 is insufficient to establish support for a particle size range, as now claimed.

Conclusion

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571) 272-1110. The examiner can normally be reached on 6:00 a.m. - 2:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *Jmr*
02/27/05